



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/553,165 | 08/04/2006 | Karl Heinz Schmid | C 2869 PCT/US | 9073 |
| 23657 | 7590 | 03/26/2010 | | |
| FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648 | | | | |
| EXAMINER | | | | |
| VENKAT, JYOTHSNA A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1619 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 03/26/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

10/553,165

Applicant(s)

SCHMID ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Amendment dated 10/14/05 cancelled claims 1-13 and added claims 14-36. Claims 14-36 are pending in the application.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 14-35 are, drawn to cosmetic composition and antiperspirant or deodorant composition.

Group II, claim(s) 36 is, drawn to pharmaceutical composition.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions." Moreover, as stated in Rule 13.2 PCT, Unity of Invention is satisfied "where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art so linked as to form a single general inventive concept." The instant composition claim 14 does not present a contribution over the prior art. Claim 14 lacks inventive step. Claim 14 is obvious over the combination of U. S. Patents 6,133,209 ('209) and 5,833,963 ('963). Patent '208 teaches polyolefins and their functionalized derivatives and teaches at abstract that these polyolefins are useful as lubricants. Patent '209 at col.18, ll 54-56 teaches oligobut-1-ene and this is same as oligo- 1-butene and teaches the preparation of oligo butene, oligo propene at col.18, line 55 through col.19, line 5. These olefins are drawn to claimed linear α - olefin containing 4 to 10 carbon atoms and butene belongs to 4 carbon atoms. Patent '209 does not teach the lubricants being useful for cosmetics. However, patent '963 teaches antiperspirant compositions and

teaches at col.5,II 24-50 adding UCON® compounds, which are lubricants. Accordingly it would be obvious to use oligo α -olefin compound obtained by oligomerization of linear α -olefin taught by patent '209 as lubricants and substitute these lubricants for lubricants of patent '963 drawn to antiperspirant compositions.

As a result, as currently presented, the instant cosmetic composition claim does not share a special technical feature with the instant pharmaceutical claim 36 and, as such, unity between the above Groups I - II is broken.

Election of Species

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) At least one branched α -olefin containing 5 to 18 carbon atoms
- b) At least one linear α -olefin containing 4 to 10 carbon atoms,
- c) A mixture of a branched α -olefin containing 4 to 18 carbon atoms and a linear α -olefin containing 3 to 18 carbon atoms
- d) A mixture of various branched α -olefins containing 4 to 18 carbon atoms and linear α -olefins containing 3 to 18 carbon atoms

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

15-21 and 29-32

The following claim(s) are generic: 14, 22-28 and 33-36.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Claim 14 is obvious over the combination of U. S. Patents 6,133,209 ('209) and 5,833,963 ('963). Patent '208 teaches polyolefins and their functionalized derivatives and teaches at abstract that these polyolefins are useful as lubricants. Patent '209 at col.18, ll 54-56 teaches oligobut-1-ene and this is same as oligo- 1-butene and teaches the preparation of oligo butene, oligo propene at col.18, line 55 through col.19, line 5. **These olefins are drawn to claimed linear α -olefin containing 4 to 10 carbon atoms** and butene belongs to 4 carbon atoms. Patent '209 does not teach the lubricants being useful for cosmetics. However, patent '963 teaches antiperspirant compositions and teaches at col.5, ll 24-50 adding UCON® compounds, which are lubricants. Accordingly it would be obvious to use oligo α -olefin compound obtained by oligomerization of linear α -olefin taught by patent '209 as lubricants and substitute these lubricants for lubricants of patent '963 drawn to antiperspirant compositions.

Due to complexity of the action, examiner submitted Election Requirement in writing in lieu of calling applicants' attorney.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/553,165
Art Unit: 1619

Page 6

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619